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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,801	05/26/2000	Kenneth Kiron	3001 P 009	8044

7590 03/24/2006

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EXAMINER

HAVAN, THU THAO

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,801

Applicant(s)

KIRON ET AL.

Examiner

Thu Thao Haven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 120-123 and 135-161 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 120-123 and 135-161 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Detailed Action

Response to Amendment

Claims 120-123 and 135-161 are pending. This action is in response to the amendment received December 27, 2005.

Response to Arguments

Applicant's arguments with respect to claims 120-123 and 135-161 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 120-123 and 135-161 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,088,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 120-123 and 135-161 of pending

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application 09/579,801 are the same method for intended use as claims 1-34 of U.S. Patent No. 6,088,685. The additional limitation discloses by application 09/579,801 is "trading the outstanding shares of the trust on an exchange throughout a trading day" while all the other limitations in claims 120-123 and 135-161 are the same as claims 1-34 of U.S. Patent No. 6,088,685.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **120-123 and 135-161** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien (US 5,101,353) in view of Fox (US 5,132,899) and further in view of Lucas et al. (US 4,751,640).

Re claims **120, 135, 141, 147, and 153-159**, Lupien teaches a method comprising the steps of:

identifying a plurality of securities within a similar industry (col. 3, lines 15-31; col. 10, lines 1-8 and lines 38-51);

separating the plurality of securities within the similar industry into a group satisfying market capitalization criteria (col. 3, lines 28-37; col. 4, lines 45-61; col. 10, lines 1-20; col. 11, lines 51-60);

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creating an exchange traded having a number of outstanding shares and comprising securities within the group (col. 3, lines 15-31; col. 10, lines 1-8 and lines 38-51);

only changing the securities comprising in response to changes in the securities in the group (col. 3, lines 15-31; col. 3, line 62 to col. 4, line 65; col. 7, lines 30-36; col. 10, lines 14-36);

trading the outstanding shares of the trust on an exchange at a price corresponding to a real time calculated value of the securities in the group, wherein the real time calculated value is electronically calculated in real time based on a user-defined method of weighing the securities within the trust (col. 3, lines 7-45; col. 4, lines 49-53);

generating at least an end of day net asset value of the trust (col. 4, lines 32-41); and outputting an indication of the real time calculated value in a humanly readable format. (figs. 4-6).

However, Lupien does not explicitly teach trusts. On the other hand, Fox discloses trusts (col. 1, lines 13-42). Fox discloses taxable trust investment accounts such as REITS. Thus, it would have been obvious to one of ordinary skill in the art to use a legal entity with various legal protections such as a blind trust for financial instruments to prevent conflict of interest as discloses in Fox.

Furthermore, Lupien and Fox do not explicitly teach trading throughout a trading day. On the other hand, Lucas discloses trading throughout a trading day (col. 1, lines 10-40; col. 2, lines 20-40; abstract). Lucas discloses automated investment system that allows customers to trading throughout a trading day. Thus, it would have been obvious to one of

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ordinary skill in the art to enable trading any amounts and types of funds or trust throughout a trading day in an automated investment system as discloses in Lucas.

Re claims **121, 138, 144, and 150**, Lupien teaches creating and listing a derivative of the outstanding shares (abstract).

Re claims **122, 137, 139-140, 143, 145-146, 149, 151-152, and 160-161**, Lupien teaches portfolio are changed based on one or more of the following criteria: purchase constraints, brokerage availability. capitalization, dividends, securities not available for purchase, change in class of shares and risk /return ratio (col. 3, lines 15-45; col. 4, lines 24-65; col. 10, lines 1-36; col. 11, lines 15-60; col. 7, lines 30-36).

Re claim **123**, Lupien teaches clearing trades (col. 4, lines 32-41).

Re claims **136, 142, and 148**, Lupien teaches generating an account statement representing an ownership interest (figs. 4-6).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pritchard, US 2002/0046154

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH
3/19/2006



HANI M. KAZIMI
PRIMARY EXAMINER